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# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

452000

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on October 27, 2005

Signature Patricia A. Van Hecke

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Application Number

10/633,799

Filed

08/04/2003

First Named Inventor

Steven Dibdin

Art Unit

3727

Examiner

Lien M. Ngo

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

**Five pages of Remarks are attached.**

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 35,118

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Robert W. Diehl  
Signature

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Telephone number

October 27, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 2 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## REMARKS

### Claim Status

Claims 1-10 are currently pending and at issue.

Claims 1, 3-6 and 8-10 have been finally rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 3,739,938 to Paz (hereinafter "Paz")

Claims 1-3, 6 and 7 have been finally rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 5,875,941 to Hsu (hereinafter "Hsu").

Claims 1 and 3-9 have been finally rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,65,302 to Lin (hereinafter "Lin").

Applicant believes each of these rejections is based on an error in fact. Accordingly, such rejections should be withdrawn as improper. The errors are presented in the following arguments with respect to each cited reference.

### The Paz Reference

With respect to Paz, the examiner contends that, with reference to Fig. 2, "the space voided between the member 30 and member 12" or "the space voided between member 20 and member 23" constitutes a recess defined by a cap—the element of Paz corresponding to the cap is not made clear (see Paper No. [unmarked], dated 7/29/05, page 2). Applicant's invention clearly requires a "cover assembly including a cap defining a recess" in Claim 1. Referring to the present application, the cap 110 is a component which fits over the top 60 of the cover assembly 40 (see also Application page 5, second paragraph, and FIG. 4). Paz provides no cap as part of the cover assembly. To contend otherwise is clearly an error in fact.

Further, the space voided between members 30 and 12 of Paz is clearly not "open to ambient" as required of Claim 1. In fact, that area is completely isolated and sealed from ambient. As to the area voided between members 20 and 23, review of Fig. 1 of Paz shows that

this area is not a recess at all. Rather, members 20 and 23 are raised areas on the surface.

Accordingly, neither of the areas meets the limitation of a “recess open to ambient.” To contend otherwise is clearly an error in fact.

The examiner also points to “the void where the member 26 goes through” as corresponding to the claimed element “the cap having an aperture therethrough.” However, the examiner ignores the last component of that limitation which states “spaced from the recess.” The particular aperture noted by the examiner passes right through the middle of both areas alleged to be recesses. Accepting, for the sake of argument, that either area alleged to be a recess by the examiner is such, then the aperture (i.e., “the void where the member 26 goes through”) is clearly not spaced from the recess as required. Accordingly, Paz does not meet this requirement of Claim 1. To contend otherwise is clearly an error in fact.

Finally, Claim 1 requires “a drain/drink passage communicating with the recess.” The examiner points to passage 21 of Paz. This passage does not communicate with either area alleged to be a recess—again, accepting this limitation only for the sake of argument. Accordingly, Paz clearly does not meet this requirement of Claim 1. To contend otherwise is clearly an error in fact.

In summary, referring to Claim 1, Paz fails to disclose:

- (1) a cap as part of the cover assembly;
- (2) a recess open to ambient and defined by the cap;
- (3) an aperture through the cap spaced from the recess; and
- (4) a drain/drink passage communicating with the recess.

Clearly, rejection of independent Claim 1 under 102(b) as anticipated by Paz is without merit. Claims 3-6 and 8-10 merely depend from Claim 1 adding further limitations. A prima

facie case of anticipation by Paz as to Claims 1, 3-6 and 8-10 has not been made and this rejection should be withdrawn.

The Hsu Reference

With respect to Hsu, the examiner contends FIGS. 5, 6 and 9 disclose:

a recess 331 or 3, an aperture 32, a drink passage 33, a valve assembly 41 having an actuator mechanism or a push button 21 including a toggle mechanism 41 so that alternate actuations of the actuator mechanism respectively latch the valve assembly in its open and close conditions.

[Pages 2-3 of Action of 7/29/05]

Applicant has argued that Hsu fails to disclose a recess open to ambient and “a cap” as required by Claim 1 (see “Remarks” page 6 of AMENDMENT, filed May 26, 2005). Applicant has also argued against Hsu as failing to teach a “toggle mechanism” which latches the actuator mechanism in open and closed conditions on alternating actuations.

Considering the alleged “recess” of Hsu first, it is difficult to understand how the “open bottom end 331 of the fluid conduit 33” or the “valve seat member 3” is even similar to “a recess open to ambient” as set forth in Claim 1. And again, the examiner has pointed to no element of the Hsu device as a “cap defining a recess,” other than to merely say it exists. The two alternative elements alleged to be a recess, i.e., end 331 and member 3, do not open to ambient nor are they recesses. To contend otherwise is a clear error in fact.

Member 3 is a vertical wall of the device, and end 331 opens in one direction to the container 7 and in the other direction to the passage 33, which in turn opens to the inside of a pouring spout (see FIG. 9 of Hsu). Accordingly, Hsu fails to disclose a recess open to ambient as required by Claim 1.

As to the aperture (i.e., “cap having an aperture therethrough”), the examiner has pointed to guiding space 32. However, this space does not go through the cap—assuming, for the sake of argument, that the cap is cap body 1 of the Hsu device. Aperture 32 of Hsu only goes about halfway into the device before ending. Accordingly, Hsu fails to disclose a “cap having an aperture therethrough” as required by Claim 1.

Further, as to Claim 7, Hsu does not disclose a mechanism which latches into an open condition and a closed condition on alternative actuations. The device of Hsu requires removing the device from the container and manipulating the valve piece 41 while it is in a downward position (Col. 3, lines 18-28, and FIGS. 7 and 8). Applicant refers to the “Remarks” section, specifically, the bridging paragraph between pages 6 and 7, of AMENDMENT, filed May 26, 2005, as further explanation on this point. Accordingly, Hsu fails to disclose a toggle mechanism as required by Claim 7.

Clearly, rejection of independent Claim 1 under 102(b) as anticipated by Hsu is without merit. Claims 2-3, 6 and 7 merely depend from Claim 1 adding further limitations. A prima facie case of anticipation by Hsu as to Claims 1-3, 6 and 7 has not been made and this rejection should be withdrawn.

#### The Lin Reference

With respect to Lin, the examiner contends the reference:

discloses, in fig. 2, a beverage container comprising a base (coffee mug), a removable cover 20 having a cap defining a recess (the annular bottom of member 32), an aperture 24, a drink passage 28, a valve assembly 52 having a push button 64 disposed centrally of the cap, a vent (another passage 28), and a toggle mechanism 26.

[Final Office Action, p. 3]

First, and only for the sake of clarity, there is no coffee mug shown in any of the figures of Lin. Applicant is willing to accept, however, that a coffee mug would be disclosed to a person of skill in the art. However, the factual errors of the remaining contentions are another matter.

The examiner again fails to point to any structure disclosed within Lin as disclosing a cap. The examiner does contend that a cap defining a recess is represented in “the annular bottom of member 32.” The only view which shows the bottom of member 32 is FIG. 4. There is absolutely no way, given the view of FIG. 4, that it could possibly show the presence of a recess. Additionally, even if it were a recess, it is on the underside of the lid and, therefore, not open to ambient as required. Further, the aperture 24 indicated by the examiner goes right through the center of this supposed recess. Claim 1 requires the aperture to be “spaced from the recess.” These are all very clearly errors of fact.

As to other elements of pending claims, the examiner contends the twist knob 64 of Lin is a push button as set forth in Claim 3. Referring to Lin, bridging paragraph between columns 4 and 5, the twist knob biases open a valve plate to create an opening and then returns the valve plate to a seated position to close the opening. It does not latch the valve assembly open and closed, as required by Claim 7. To contend otherwise is an error of fact.

Clearly, rejection of independent Claim 1 under 102(e) as anticipated by Lin is without merit. Claims 3-9 merely depend from Claim 1 adding further limitations. A prima facie case of anticipation by Lin as to Claims 1 and 3-9 has not been made and this rejection should be withdrawn.

All claims are considered to distinguish over the cited references, Paz, Hsu, and Lin, for the reasons stated above and those of record.